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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,720	03/29/2004	Byung-Jin Kim	1740-000011/US/COA	9364

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON, VA 20195

EXAMINER

CHEVALIER, ROBERT

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,720

Applicant(s)

KIM ET AL.

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 7-12 are rejected under 35 U.S.C. 101 because the claim is directed to a recording medium storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. See, e.g. Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Mishima et al.

Mishima et al discloses a video reproducing apparatus that shows all the limitations recited in claims 1, 4, and 7, including the feature of outputting I-picture and a

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number of P-pictures as a still picture based on the video data as specified in the present claims 1, 4, and 7. (See Mishima et al's page 8, paragraph [0073], lines 9-13).

With regard to claims 2, 5, and 8, the feature of outputting P-pictures that represent a same picture as the I-picture as specified thereof is present in Mishima et al. (See the capability of outputting one screen area accordance with the I-picture and the P-picture as specified in Mishima et al's claim 9, lines 26-28).

With regard to claims 3, 6, and 9, the feature of the number of P-pictures being greater than 1 as specified thereof is present in Mishima et al. (See Mishima et al's claim 9, lines 22-25).

5. Claims 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Juri et al (P.N. 5,999,693).

Juri et al discloses a video recording/reproducing apparatus which shows the same limitations recited in claims 10, and 13-14, including the feature of the data area storing video data (See the main video area shown in Juri et al's Figure 1B), the feature of the navigation area (See the video auxiliary area shown in Juri et al's Figure 1b) storing navigation data separated from the data area for managing reproduction of the video data, the navigation data indicating if the video data includes a still picture as specified in the present claims 10, and 13-14. (See the still picture flag shown in Juri et al's Figure 1b).

With regard to claim 11, the feature of identifying a portion of the video data including the still picture as specified thereof is present in Juri et al. (See the still picture flag shown in Juri et al's Figure 1b).

With regard to claim 12, the feature of the optical disc specified thereof is present in Juri et al. (See Juri et al's column 11, lines 9-10).

Response to Arguments

6. Applicant's arguments filed 10/12/06 have been fully considered but they are not persuasive.

Regarding the Applicant's argument in that the cited reference of Juri et al fails to specifically disclose the feature of the navigation area being separated from the data area because the image flag is part of the first video auxiliary data that is connected to the main video and that the Juri et al's recording medium is not an optical disc, Examiner disagrees. It is noted that Figures 1b-c of Juri et al disclose that the auxiliary data area wherein the still image flag is located is clearly separated from the main video data area. It is further to be noted also that Juri et al clearly discloses that the recording medium can also be an optical disc. (See Juri et al's column 11, lines 9-10).

Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 571-272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B. Chevalier
November 28, 2006.


ROBERT CHEVALIER
PRIMARY EXAMINER